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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEE, JOHN J

ART UNIT

PAPER NUMBER

2684

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11

Please find below and/or attached an Office communication concerning this application or proceeding.

14

Office Action Summary

Application No.

09/577,152

Applicant(s)

FACCIN ET AL.

Examiner

JOHN J LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1 – 31 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 – 24 and 36 – 42 of copending Application No. 09/636,738. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. Claims 1 – 31 of this application conflict with claims 1 – 24 and 36 – 42 of Application No. 09/636,738. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 – 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindroos (WO 95/22230) in view of Widegren et al. (US Patent number 6,621,793).

Regarding **claims 1 and 25**, Lindroos discloses that a method for coordinating charging information in a communications network (Fig. 1, 3, abstract, and pages 3, lines 1 – 29). Lindroos teaches that establishing a communication channel (Fig. 1 and pages 4, lines 24 – page 5, lines 22, where teaches mobile user establishes a call connection to mobile communication network). Lindroos teaches that associating a charging identification with said communication channel (pages 3, lines 1 – 29, Fig. 1, 3, and pages 4, lines 24 – page 5, lines 22, where teaches the unique identification code makes it possible to handle all charging information belonging to one single call). Lindroos also teaches that sending said charging identification from a first network element in the transport layer (mobile station or GPRS support node or GMSC or could be anything in Fig. 3) to a second network element in the application layer (visit network or could be anything in Fig. 3) (Fig. 3, 8 and pages 6, lines 14 – pages 7, lines 26, and pages 8, where teaches third party, mobile station, or GMSC in GSM mobile communication network (GPRS Node) transmits to charging ID information to visit network).

However, Lindroos does not specifically disclose the limitation “sending packet data from a first network element, GPRS Support Node, in the transport layer, to a second network element (Call State Control Function (CSCF)) in the application layer”.

However, Widegren discloses the limitation “sending packet data from a first network element, GPRS Support Node, in the transport layer, to a second network element (Call State Control Function (CSCF)) in the application layer” (column 17, lines 16 – column 19, lines 30 and Fig. 20, where teaches the authorization token needs to be included in the PDP context activation request, the policy control interface (between the PCF and the Gateway when the decision is forwarded from the PCF to the GGSN), and SIP signaling messages between the CSCF and UE). It would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the Lindroos system as taught by Widegren. The motivation does so would be to improve a calling control for efficient charging in mobile packet data communication system.

Regarding **claim 2**, Lindroos discloses that the second network element adds said charging identification to charging identification, which said second network element collects (pages 9, lines 1 – pages 11, lines 9 and Fig. 3, 8).

Regarding **claim 3**, Lindroos discloses that the first network element sends an address of a network element together with said charging identification to said second network element (pages 6, lines 14 – pages 7, lines 26 and Fig. 3, 5, 8).

Regarding **claim 4**, Lindroos discloses that the second network element adds said address of a network element to charging information which said second network element collects (pages 5, lines 6 – pages 7, lines 26 and Fig. 3, 5, 8).

Regarding **claim 5**, Lindroos discloses that the first network element sends security information together with said charging identification to said second network element (pages 6, lines 14 – pages 8, lines 11 and Fig. 3, 5, 8).

Regarding **claim 6**, Lindroos discloses that the second network element verifies said charging identification against said security information (pages 5, lines 6 – pages 8, lines 11 and Fig. 3, 5, 8).

Regarding **claims 7 and 26**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1.

Regarding **claims 8 and 27**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that the charging identification is a GGSN allocated Charging ID (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claims 9 and 28**, Lindroos discloses that the first network element is Mobile Station (MS) (pages 3, lines 1 – 29, Fig. 1, 3, and pages 4, lines 24 – page 5, lines 22).

Regarding **claims 10 and 29**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that the first network element is Serving GPRS Support Node (SGSN) (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claims 11 and 30**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that the first

network element is a Gateway GPRS Support Node (GGSN) (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claims 12 and 31**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1.

Regarding **claim 13**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that an SGSN sends the address of a network element to said first network element (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claim 14**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that the address of a network element is an address of a GGSN (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claim 15**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that the transport layer is a GPRS/UMTS (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claim 16**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that the transport layer is Packet Switched Core Network domain (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claim 17**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that the application layer is

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a IP Multimedia Core Network domain (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claim 18**, Lindroos and Widegren disclose the all the limitation, as discussed in claim 1. Furthermore, Lindroos further discloses that the communication network is a packet switched wireless network (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claim 19**, Lindroos discloses that sending said charging identification is performed autonomously (pages 3, lines 1 – 29, Fig. 1, 3, and pages 4, lines 24 – page 5, lines 22).

Regarding **claim 20**, Lindroos discloses that sending said charging identification is performed based on a request from said second network element (pages 3, lines 1 – 29, Fig. 3, 8, and pages 6, lines 14 – pages 8, lines 11).

Regarding **claim 21**, Lindroos discloses that the second network element sends said charging identification towards an endpoint of a communication (Fig. 3, 8 and pages 6, lines 14 – pages 8, lines 11).

Regarding **claim 22**, Lindroos discloses that the second network element sends security information together with said charging identification toward said endpoint of a communication (pages 6, lines 14 – pages 8, lines 11 and Fig. 3, 5, 8).

Regarding **claim 23**, Lindroos discloses that the second network element sends an address of a network element together with said charging identification to said endpoint of a communication (pages 6, lines 14 – pages 7, lines 26 and Fig. 3, 5, 8).

Regarding **claim 24**, Lindroos and Widegren disclose all the limitation, as discussed in claims 1 and 4.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Donovan et al. (US Patent number 6,453,158) discloses Wireless Prepaid Platform Integration with Standard Signaling.

Sayers et al. (US 2003/0186694) discloses Integrated Wireless Communications In Private and Public Network Environments.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
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or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(703) 306-5936**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay**

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Aung Maung, can be reached on (703) 308-7745. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L.
June 23, 2004

John J Lee


NICK CORSARO
PATENT EXAMINER